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Paper No. 8.

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In re Application of
Stuber et al.
Application No. 10/086,786
Filed: February 28, 2002
Attorney Docket No.: L13.12-0174/01-262

: OFFICE OF PETITIONS
: ON PETITION
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This is a decision on the petition filed under 37 CFR 1.137(a) on February 6, 2004, seeking to revive the above-identified abandoned application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a), or as explained below, 1.137(b)."

The application was deposited with four drawing figures on 3 sheets of drawings. On April 4, 2002, the Office of Initial Patent Examination (OIPE) mailed Notice requiring substitute drawings within an extendible period of 2 months as those of record did not have margins that complied with 37 CFR 1.84(g).

On June 4, applicants filed a reply.

However, on June 17, 2002, OIPE sent a Notice advising applicants that the reply of June 4, 2002, was incomplete, and that the first period for reply continued to run.

As no further reply was received, and no extensions of time were filed, this application became abandoned midnight on June 4, 2002. A Notice of Abandonment was mailed January 14, 2004.

The instant petition was filed February 6, 2004, accompanied by four sheets of acceptable drawings containing Figures 1-4, a declaration by Manu Kashyap that on June 4, 2002, he mailed two (2) sheets of drawings to the USPTO by way of the Express Mail procedure set forth in 37 CFR 1.10, a copy of the Express Mail label for that mailing, and a copy of an itemized postcard receipt for this application bearing a USPTO date stamp of June 4, 2002, that acknowledges receipt of formal drawings for this application.

Applicants seek withdrawal of the holding of abandonment or alternately, revival under 37 CFR 1.137(a).

With respect to withdrawal of the holding of abandonment:

It is noted that abandonment occurs by operation of law for failure to prosecute. See 35 USC 133. Applicants contend that a reply--albeit a flawed reply-- was timely filed on June 4, 2002. As noted in 37 CFR 1.135(b), in order to avoid abandonment applicant must take such prosecution measures that include complete and proper reply as the condition of the application may require.

Applying that rule to the facts of this case, applicant had to file on June 4, 2004, replacement sheets of drawings that had proper margins as required by 37 CFR 1.84(g), in order to avoid abandonment. Applicants admit, with commendable candor, that Mandu Kashyap erred and filed the wrong drawings (but 2 sheets containing 2 Figures whereas 4 Figures regardless of the number of sheets were needed) on June 4, 2002. Thus, since a complete and proper reply to the Notice was not timely filed, there can be no doubt that this application was properly held abandoned.

Applicants further contend that USPTO could have notified applicants of their flawed reply. In fact the USPTO did send out such a communication, but such is immaterial to the fact and date of abandonment. Although the USPTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so. See In re Colombo Inc., 33 USPQ2d 1530, 1532. (Comm'r Pat. 1994). Rather, it is the applicants who are ultimately responsible for filing proper documents. Id. Furthermore, petitioners concededly received the Notice but failed to provide the complete (and timely) reply. The failure to supply the proper reply was the fault of petitioners, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioners had received the reasonable notice required so as ensure a timely and full response to the Notice. That petitioners failed to timely and adequately respond was unfortunate, but such failure did not operate to save this application from abandonment. See Brenner, supra. Accordingly the holding of abandonment was proper and will not be withdrawn.

With respect to the petition to revive:

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, the publication fee, or any portion of each fee, the required reply must be the payment of the issue fee, publication fee or any outstanding balance of each fee; (2) the petition fee set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and (4) in some instances, a terminal disclaimer and fee (not applicable to this application). This petition lacks item (3) noted above.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances,

such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Assuming that the error herein is a clerical error on the part of Manu Kashyap, then as noted in MPEP 711.03(c) §(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds* sub nom., *Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

ALTERNATE VENUE

In the event that petitioner is not able, or does not wish, to provide the necessary showing of unavoidable delay, petitioner may present a petition and fee under the less stringent "unintentional" delay standard, which does not require such a showing, and also in most cases, the documentation to support the assertions made in the petition.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee of \$665 set forth in § 1.17(l); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and (4) in some instances, a terminal disclaimer and \$55 fee (not applicable here).

Petitioner should not construe the mere informative mention of this alternate venue that revival even under this standard is possible. Petitioner is advised, before considering this alternate venue, to reflect on the additional expense and the fact that if any part of the delay in prosecuting, or reviving this case is found to have been intentional, such will preclude revival even under the less stringent "unintentional" standard.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this communication should be directed to Paralegal Irwin Dingle at (703) 306-5684.



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Patent Examination Policy